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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/082,300	02/26/2002	Naoki Tsuchitoi	03500.016242	2783

5514 7590 10/19/2005

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NEW YORK, NY 10112

EXAMINER
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HUNTSINGER, PETER K

ART UNIT	PAPER NUMBER
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2624

DATE MAILED: 10/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/082,300

Applicant(s)

TSUCHITOI, NAOKI

Examiner

Peter K. Huntsinger

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

DOUGLAS Q. TRAN  
PRIMARY EXAMINER

*Tranlong*

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 21 and 22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer program claimed is merely a set of instructions per se. Since the computer program is merely a set of instructions not embodied on a computer readable medium to realize the computer program functionality, the claimed subject matter is not statutory. See MPEP § 2106 IV.B.1.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 2, 3, 12, 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 2 and 12 recite the limitation "the print job having a lower priority level" in page 36, line 26, and page 40, line 16. There is insufficient antecedent basis for this

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limitation in the claim. The phrase should be replaced with "a print job having a lower priority level" or "the print job, which has a lower priority level".

4. The term "lower priority level" in claims 2, 3, 12, and 13 is a relative term which renders the claim indefinite. The term "lower priority level " is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. An indication of what the priority level is lower than is needed within the claim.

5. Claims 3 and 13 recite the limitation "the print data having an older receiving time" in page 37, line 5, and page 40, lines 22 and 23. There is insufficient antecedent basis for this limitation in the claim. The phrase should be replaced with "print data having an older receiving time" or "the print data, which has an older receiving time".

6. The term "older receiving time" in claims 3 and 13 is a relative term which renders the claim indefinite. The term " older receiving time" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. An indication of what the receiving time is older than is needed.

7. Claim 14 recite the limitation "said breaching means" in page 41, line 2. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-3 and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchitoe Patent 5,872,900, Taniguchi et al. Patent 6,348,972, and Ashizaki et al. Patent 6,683,699.

Referring to claim 1, Tsuchitoe discloses a printer controller for controlling the printing of print data transferred from an external device and stored, comprising: storage means, input means, display control means for displaying, and selection means (col. 4, lines 22-25). The computer by definition must include storage means, input means, output means, and a processor. Tsuchitoe does not disclose expressly authentication information. Taniguchi et al. disclose storage means for storing the print data and authentication information corresponding to the print data (Auxiliary memory D1 of Fig. 1, col. 3, lines 34-43); input means for enabling a user to input the authentication information to print the print data (Input device 22 of Fig. 4, col. 7, lines 24-27); display control means (Display 20 of Fig. 4, col. 7, lines 11-15) for displaying a list of print data corresponding to the input authentication information on a display panel by collating the authentication information input by said input means with the authentication information stored in said storage means (S611 of Fig. 6, col. 7, lines 29-33); selection means for enabling the user to select at least one print data from the list of print job displayed on said display panel (col. 7, lines 16-19). Tsuchitoe and Taniguchi et al. are combinable

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because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the secure printing system of Taniguchi et al. in the printer controller of Tsuchitoui. The motivation for doing so would have been to implement the security system in a printer controller without requiring a separate outside memory device or a printer with a display and keyboard. Further, since the printer controller is contained in a computer, the computer would already include the storage, display, and keyboard. Tsuchitoui does not disclose expressly a charging means. Ashizaki et al. disclose control means for controlling the printing of the selected print data after confirming that a print charge for printing the print data selected by said selection means is paid (col. 18, lines 48-54). Tsuchitoui and Ashizaki et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to allow the printer controller of Tsuchitoui to charge for printing. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Taniguchi et al. and Ashizaki et al. with Tsuchitoui to obtain the invention as specified in claim 1.

Referring to claim 2, Taniguchi et al. disclose wherein said storage means has breaching means for breaching the print job having a lower priority level that is retrieved, upon detecting that said storage means can not store the print data anymore (col. 4, lines 58-63).

Referring to claim 3, Taniguchi et al. disclose wherein the print data having lower priority level means the print data having an older receiving time (col. 6, lines 49-60).

Referring to claim 5, Taniguchi et al. disclose judgement means for judging whether or not a predetermined period has passed since the print data is received, and breaching means for breaching the print data, if said judgement means judges that the predetermined period has passed since the print data is received (col. 10, lines 9-17).

Referring to claim 6, Tsuchitai discloses a printer controller that can communicate with an information processing apparatus for storing the print data transferred from an external device, comprising: input means, acquisition means, display control means, selection means, and data acquisition means (col. 4, lines 22-25). The computer by definition must include storage means, input means, output means, and a processor. Tsuchitai does not disclose expressly authentication information. Taniguchi et al. disclose input means with which the user inputs the authentication information to print the print data (Input device 22 of Fig. 4, col. 7, lines 24-27); acquisition means for acquiring the information indicating the print data corresponding to the input authentication information from said information processing apparatus by transmitting the authentication information input by said input means to said information processing apparatus (S611 of Fig. 6, col. 7, lines 29-33); display control means for displaying a list of print data corresponding to the input authentication information on a display panel in accordance with the information acquired by said acquisition means (Display 20 of Fig. 4, col. 7, lines 11-15); selection means with which the user selects at least one print data from the list of print data displayed on said display panel (col. 3, lines 16-19); data acquisition means for acquiring the selected print data from said information processing apparatus by requesting the print data

selected by said selection means of said information processing apparatus (S612 of Fig. 6, col. 7, lines 34-39). Tsuchitai and Taniguchi et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary skill in the art to implement the secure printing system of Taniguchi et al. in the printer controller of Tsuchitai. The motivation for doing so would have been to implement the security system in a printer controller without requiring a separate outside memory device or a printer with a display and keyboard. Further, since the printer controller is contained in a computer, the computer would already include the storage, display, and keyboard. Tsuchitai does not disclose expressly a charging means. Ashizaki et al. disclose control means for controlling the printing of the print data acquired by said acquisition means after confirming that a print charge for printing the print data selected by said selection means is paid (col. 18, lines 48-54). Tsuchitai and Ashizaki et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to allow the printer controller of Tsuchitai to charge for printing. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Taniguchi et al. and Ashizaki et al. with Tsuchitai to obtain the invention as specified in claim 6.

Referring to claim 7, Ashizaki et al. disclose wherein said data acquisition means requests the selected print data of said information processing apparatus after confirming that the print charge for printing the print data selected by said selection means is paid (col. 21, lines 40-50).



Referring to claim 8, Taniguchi et al. disclose wherein said acquisition means acquires the information indicating a name given to the print data corresponding to the input authentication information (S608 of Fig. 6, col. 7, lines 16-19).

Referring to claim 9, Taniguchi et al. disclose wherein said data acquisition means receives the selected print data from said information processing apparatus by transmitting the information indicating the selected print data to said information processing apparatus (S608 of Fig. 6, col. 7, lines 16-19).

Referring to claim 10, Taniguchi et al. disclose the printer controller according to claim 6, wherein said control means deletes the acquired print data after printing the print data acquired by said data acquisition means (S615 of Fig. 6, col. 7, lines 49-52).

10. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchitoi Patent 5,872,900, Taniguchi et al. Patent 6,348,972, and Ashizaki et al. Patent 6,683,699 as applied to claim 2 and above, and further in view of Reifman et al. Patent 5,438,433.

Referring to claim 4, Taniguchi et al. disclose notification means for notifying when the print data is breached by said breaching means (col. 4, lines 58-63). Taniguchi et al. does not disclose expressly notifying a destination address when the print data is breached. Reifman et al. disclose notification means for notifying a destination address set up when an error occurs. Taniguchi et al. and Reifman et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary in the art to notifying a

destination address when the print data is breached. The motivation for doing so would have been to provide a convenient method of alerting the user that their print data will not print. Therefore, it would have been obvious to combine Reifman et al. with Taniguchi et al. to obtain the invention as specified in claim 4.

11. Claims 11-13, and 15-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al. Patent 6,348,972 and Ashizaki et al. Patent 6,683,699.

Referring to claim 11, Taniguchi et al. disclose a data processing method for providing a print service using a storage device (Auxiliary memory D1 of Fig. 1, col. 3, lines 34-43) for storing the print data transferred from an external device and the authentication information corresponding to the print data, and a printer, comprising the steps of: displaying a list of print data corresponding to the input authentication information on a display panel (Display 20 of Fig. 4, col. 7, lines 11-15) by collating the authentication information input by the user to print the print data with the authentication information stored in said storage means (S611 of Fig. 6, col. 7, lines 29-33); recognizing at least one print data selected by the user from the list of print job displayed on said display panel (S612 of Fig. 6, col. 7, lines 34-39). Taniguchi et al. do not disclose expressly a charging means. Ashizaki et al. disclose controlling the printer to perform the printing of the selected print data after confirming that a print charge for printing the selected print data is paid (col. 18, lines 48-54). Taniguchi et al. and Ashizaki et al. are combinable because they are from the same field of printing systems.

At the time of the invention, it would have been obvious to charge for printing documents. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Ashizaki et al. with Taniguchi et al. to obtain the invention as specified in claim 11.

Referring to claim 12, Taniguchi et al. disclose the step of breaching the print job having a lower priority level that is retrieved, upon detecting that said storage means can not store the print data anymore (col. 4, lines 58-63).

Referring to claim 13, Taniguchi et al. disclose wherein the print data having lower priority level means the print data having an older receiving time (col. 6, lines 49-60).

Referring to claim 15, Taniguchi et al. disclose further comprising the step of judging whether or not a predetermined period has passed since the print data is received, and breaching the print data, if it is judged that the predetermined period has passed since the print data is received (col. 10, lines 9-17).

Referring to claim 16, Taniguchi et al. disclose a data processing method for providing a print service using an information processing apparatus for storing the print data transferred from an external device and the authentication information corresponding to the print data, and a printer, comprising the steps of: acquiring the information indicating the print data corresponding to the input authentication information from said information processing apparatus by transmitting the authentication information input by the user to print the print data to said information processing apparatus (S611 of Fig. 6, col. 7, lines 29-33); displaying a list of print data

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corresponding to the input authentication information on a display panel (Display 20 of Fig. 4, col. 7, lines 11-15) in accordance with the acquired information (col. 3, lines 16-19); acquiring the selected print data from said information processing apparatus by requesting at least one print data selected by the user from the list of print data displayed on said display panel of said information processing apparatus (S612 of Fig. 6, col. 7, lines 34-39). Taniguchi et al. do not disclose expressly a charging means. Ashizaki et al. disclose controlling said printer to perform the printing of the acquired print data after confirming that a print charge for printing the selected print data is paid (col. 18, lines 48-54). Taniguchi et al. and Ashizaki et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to charge for printing documents. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Ashizaki et al. with Taniguchi et al. to obtain the invention as specified in claim 16.

Referring to claim 17, Ashizaki et al. disclose the step of requesting the selected print data of said information processing apparatus after confirming that the print charge for printing the selected print data is paid (col. 21, lines 40-50).

Referring to claim 18, Taniguchi et al. disclose the step of acquiring the information indicating a name given to the print data corresponding to the input authentication information from said information processing apparatus (S608 of Fig. 6, col. 7, lines 16-19).

Referring to claim 19, Taniguchi et al. disclose the step of receiving the selected print data from said information processing apparatus by transmitting the information indicating the selected print data to said information processing apparatus (S608 of Fig. 6, col. 7, lines 16-19).

Referring to claim 20, Taniguchi et al. disclose the step of deleting the acquired print data from the printer after the end of printing the acquired print data (S615 of Fig. 6, col. 7, lines 49-52).

Referring to claim 21, Taniguchi et al. disclose a control program that is run on a computer for controlling the printing of the print data transferred from an external device and stored (col. 3, lines 16-23), comprising: a storage step of storing the print data and authentication information corresponding to the print data (Auxiliary memory D1 of Fig. 1, col. 3, lines 34-43); an input step of enabling a user to input the authentication information to print the print data (Input device 22 of Fig. 4, col. 7, lines 24-27); a display control step of displaying a list of print data corresponding to the input authentication information on a display panel (Display 20 of Fig. 4, col. 7, lines 11-15) by collating the authentication information input by said input means with the authentication information stored in said storage means (S611 of Fig. 6, col. 7, lines 29-33); a selection step of enabling the user to select at least one print data from the list of print job displayed on said display panel (col. 7, lines 16-19). Taniguchi et al. do not disclose expressly a charging for printing. Ashizaki et al. disclose a control step of controlling the printing for the print data acquired at said data acquisition step after confirming that a print charge for printing the print data selected at said selection step is paid (col. 18, lines 48-54).

Taniguchi et al. and Ashizaki et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to allow the printer controller of Tsuchitōi to charge for printing. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Ashizaki et al. with Taniguchi et al. to obtain the invention as specified in claim 21.

Referring to claim 22, Taniguchi et al. disclose a control program that is run on a computer for controlling the printing of the print data by communicating with an information processing apparatus in which the print data transferred from an external device and the authentication information corresponding to the print data are stored (col. 3, lines 16-23), comprising: an input step of enabling the user to input the authentication means to print the print data (Input device 22 of Fig. 4, col. 7, lines 24-27); an acquisition step of acquiring the information indicating the print data corresponding to the input authentication information from said information processing apparatus by transmitting the authentication information input by said input means to said information processing apparatus (S611 of Fig. 6, col. 7, lines 29-33); display control step of displaying a list of print data corresponding to the input authentication information on a display panel in accordance with the information acquired by said acquisition means (Display 20 of Fig. 4, col. 7, lines 11-15); a selection step of enabling the user to select at least one print data from the list of print data displayed on said display panel (col. 3, lines 16-19); a data acquisition step of acquiring the selected print data from said information processing apparatus by requesting the print data selected

by said selection means of said information processing apparatus (S612 of Fig. 6, col. 7, lines 34-39). Taniguchi et al. do not disclose expressly a charging for printing. Ashizaki et al. disclose a control step of controlling the printing for the print data acquired at said data acquisition step after confirming that a print charge for printing the print data selected at said selection step is paid (col. 18, lines 48-54). Taniguchi et al. and Ashizaki et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to allow the printer controller of Tsuchitoe to charge for printing. The motivation for doing so would have been to provide printed material to a customer for a profit. Therefore, it would have been obvious to combine Ashizaki et al. with Taniguchi et al. to obtain the invention as specified in claim 22.

12. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taniguchi et al. Patent 6,348,972 and Ashizaki et al. Patent 6,683,699 as applied to claim 12 and above, and further in view of Reifman et al. Patent 5,438,433.

Referring to claim 14, Taniguchi et al. disclose the step of notifying when the print data is breached by said breaching means (col. 4, lines 58-63). Taniguchi et al. does not disclose expressly notifying a destination address when the print data is breached. Reifman et al. disclose notifying a destination address set up when an error occurs. Taniguchi et al. and Reifman et al. are combinable because they are from the same field of printing systems. At the time of the invention, it would have been obvious to one of ordinary in the art to notifying a destination address when the print data is breached.

The motivation for doing so would have been to provide a convenient method of alerting the user that their print data will not print. Therefore, it would have been obvious to combine Reifman et al. with Taniguchi et al. to obtain the invention as specified in claim 14.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on (571)272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

PKH

DOUGLAS Q. TRAN  
PRIMARY EXAMINER  
